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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,099	03/22/2007	Reiner Fischer	2400.0400000/JMC/THN	6737
26111 7590 02/13/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER RODRIGUEZ-GARCIA, VALERIE	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 02/13/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,099	Applicant(s) FISCHER ET AL.	
	Examiner VALERIE RODRIGUEZ-GARCIA	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) 6,9,11-15 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

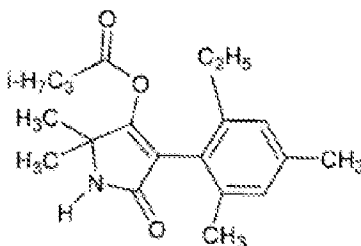
- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/15/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Claims 7, 10 and 16 have been canceled. Therefore, claims 1-6, 8-9, 11-15 and 17-19 are currently pending in this application. Claims 6, 9, 11-15 and 17-19 are withdrawn from further consideration by the Examiner pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

1. Applicant's election **with traverse** of Group I, claims 1-5 and 8, in the reply filed on 12/15/08 is acknowledged. The following elected species I-b-2 (p. 39, [0694] of US 2007/0225167) is also acknowledged:

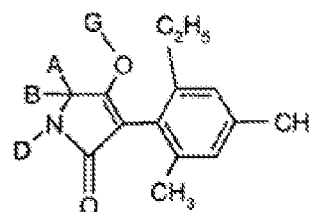


The traversal is on the ground(s) that the compounds of formula (I) are novel over WO 01/74770 A1 and that Group I shares a specific technical feature with Groups II-VI and therefore Groups I-VI share a single inventive concept. Applicants further argue that one of the criteria for a proper requirement for restriction is that "there would

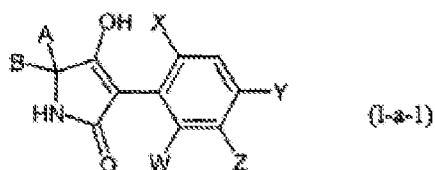
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be a serious burden on the examiner if restriction is not required", but that the search of Groups I-VI does not impose a serious burden upon the Examiner.

Applicant's arguments have been carefully considered however are not found persuasive because under PCT rule 13.1 a group of inventions should be so linked as to form a single general inventive concept. However, there is lack of unity, due that at



least one species encompassed by the generic formula (I) of claim 1 of the instant application has been disclosed in WO01/74770A1 (supplied in the IDS of 02-22-07), as cited in the previous action. The species is I-1-a-8 of the following table.



Rep.-Nr.	W	X	Y	Z	A	B	Fp. °C	Isomer
I-1-a-2	CH ₃	C ₂ H ₅	C ₂ H ₅	H	-(CH ₂) ₂ -CHCH ₃ -(CH ₂) ₂ -		154	8
I-1-a-3	CH ₃	C ₂ H ₅	C ₂ H ₅	H	-(CH ₂) ₂ -CHOCH ₃ -(CH ₂) ₂ -		225	8
I-1-a-4	C ₂ H ₅	C ₂ H ₅	C ₂ H ₅	H	CH ₃	CH ₃	200	-
I-1-a-5	C ₂ H ₅	C ₂ H ₅	C ₂ H ₅	H	-(CH ₂) ₂ -CHCH ₃ -(CH ₂) ₂ -		115	8
I-1-a-6	C ₂ H ₅	C ₂ H ₅	C ₂ H ₅	H	-(CH ₂) ₂ -CHOCH ₃ -(CH ₂) ₂ -		222	8
I-1-a-7	i-C ₃ H ₇	i-C ₃ H ₇	i-C ₃ H ₇	H	-(CH ₂) ₂ -CHOCH ₃ -(CH ₂) ₂ -		>230	8
I-1-a-8	CH ₃	C ₂ H ₅	CH ₃	H	CH ₃	CH ₃	>220	-

Thus, there is no special technical feature defining a contribution which each of the inventions, considered as a whole, makes over the prior art. As such, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as

to form a single inventive concept. In addition, search burden is a moot argument for lack of unity traversal.

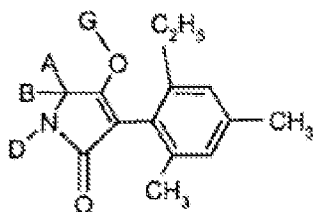
Therefore, the requirement is still deemed proper and is therefore made **Final**.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is *presented prior to* final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Note

The elected species above has been found to be free of the prior art. Thus, the examiner has expanded the search to include all species relevant to the scope of the invention of the elected subject matter.

The scope of the invention of the elected subject matter is as follows:



Compounds of formula I,

, depicted in claim 1, wherein:

G represents  **(b) and R¹, A, B and D are as defined in claim 1.**

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-5 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as hydrogen, sulfoxide, phosphate or a metal. Therefore, the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly. A reference which anticipates the elected subject matter would not render obvious the withdrawn subject matter. In addition, the fields of search are not co-extensive.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Pursuant to applicants response, claims 1-5 and 8 (in part) are the subject of this Office Action. This is the first Office Action on the merits of the claims.

Priority

2. This application is a 371 of PCT/EP04/12646 filed on 11/09/2004, which claims priority benefit of foreign application Germany 103 54 628.6 filed on 11/22/2003

This Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

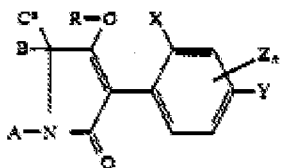
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,045,560.

The instant claims disclose a compound of the formula (I) where G is as defined above, R¹ represents C1-C6 alkyl, B represents hydrogen, D represents methyl and A represents hydrogen.

The prior art discloses compounds of the following general

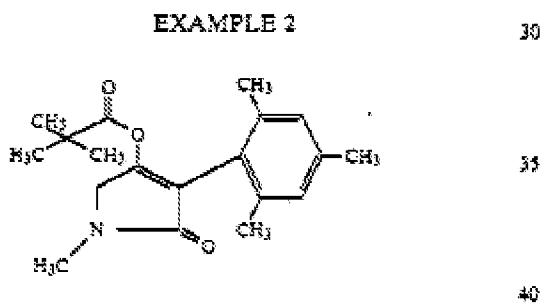


formula:

for use as pesticides, herbicides, etc. (abstract).

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The following species is found in column 13 of Patent US 5,045,560.



The difference between the prior art and the instant application is the presence of methyl versus ethyl (a longer alkyl chain) in the phenyl ring. Therefore, the claimed invention differs from the prior art only by a methyl.

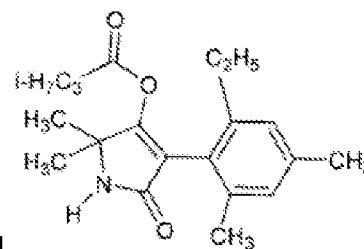
It would have been obvious to those skilled in the chemical arts at the time the claimed invention was made to make and use analogs of the compounds described in US 5,045,560 to produce the instant invention. Analogs differing only in the substitution of methyl with ethyl, are *prima facie* obvious, and require no secondary teaching. The examiner recalls *In Re Herr* 134 USPQ 176. It would be routine for the chemist to insert longer alkyl groups, such as a methyl. The experienced chemist, who would make applicants' compounds, would be motivated to prepare these compounds on the expectation that structurally similar compounds would possess similar properties and because it is routine nature to perform such experimentation in the chemical arts.

To those skilled in the art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. *In re Henze*, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious, because one skilled in the art would have been motivated to prepare

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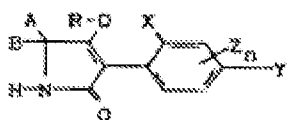
homologues of the compounds taught in the reference with the expectation of obtaining compounds which could be used in herbicidal and insecticidal compositions.

6. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent US 5,258,527.



The species elected by applicants is the compound

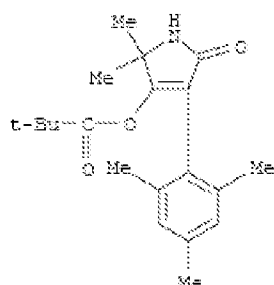
US 5,258,527 teaches compounds of the following general formula:



(I)

for use as insecticides, herbicides, etc.

(abstract).



The species

RN 139037-16-7 CAPLUS is found in Patent US

5,258,527.

The difference between the prior art and the instant application is the presence of methyl versus ethyl (a longer alkyl chain) in the phenyl ring and the presence of methyl

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versus hydrogen in the acetate (t-butyl of the prior art vs. i-propyl of the application).

Therefore, the claimed invention differs from the prior art only by a methyl in both cases.

It would have been obvious to those skilled in the chemical arts at the time the claimed invention was made to make and use analogs of the compounds described in US 5,258,527 to produce the instant invention. Analogs differing only in the substitution of methyl with ethyl, or hydrogen with methyl are *prima facie* obvious, and require no secondary teaching. The examiner recalls *In Re Herr* 134 USPQ 176. It would be routine for the chemist to insert longer alkyl groups, such as methyl or ethyl group. The experienced chemist, who would make applicants' compounds, would be motivated to prepare these compounds on the expectation that structurally similar compounds would possess similar properties and because it is routine nature to perform such experimentation in the chemical arts.

To those skilled in the art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. *In re Henze*, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious, because one skilled in the art would have been motivated to prepare homologues of the compounds taught in the reference with the expectation of obtaining compounds which could be used in herbicidal and insecticidal compositions.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

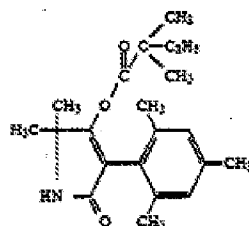
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-5 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,045,560.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are a species of the claims in the patent.

9. Claims 1-5 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7 and 10 of U.S. Patent No. 5,258,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are a species of the claims in the

18. 1-H-3-Aryl-pyrrolidine-2,4-dione derivative according to claim 1 of the formula



patent. In addition, the compound of claim 10

of the

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patent differs only by the length of the alkyl chains in both phenyl and acetate. Thus, the instant claims are obvious over U.S. Patent No. 5,258,527. See also rationale above.

10. Claims 1-5 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 12 of copending Application No. 11/666870. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from the claims of the copending Application No. 11/666870 only by the length of the alkyl chain, an ethyl instead of a methyl. See discussion above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 1-5 and 8 are also objected to as containing nonelected subject matter.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/
Primary Examiner, Art Unit 1626

/V. R. G./
Examiner, Art Unit 1626